

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-24 and 42-48 are currently pending. Claims 1, 17, 18, 22-24, 42, and 45-48 have been amended by the present amendment. The claims have been amended to address the informalities noted in the Office Action. Thus, no new matter has been added.

In the outstanding Office Action, Claim 24 was objected to as containing an informality; Claims 1-11, 18-21, and 42-45 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 1, 17, 18, 22-24, 42, and 46-48 were rejected under 35 U.S.C. § 112, second paragraph, regarding questions regarding the meaning of the term “shared” and the outcome of the determination; Claim 45 was rejected under 35 U.S.C. § 112, second paragraph, regarding a question of antecedent basis; Claims 1-14, 17-24, and 42-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,317,786 to Yamane et al. (hereinafter “the ‘786 patent”) in view of U.S. Patent No. 5,793,966 to Amstein et al. (hereinafter “the ‘966 patent”); and Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘786 patent in view of the ‘966 patent and U.S. Patent Application Publication No. 2004/0133656 to Butterworth et al. (hereinafter “the ‘656 application”).

REQUEST FOR ENTRY

This amendment is submitted in accordance with 37 C.F.R. § 1.116, which after final rejection permits entering of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action, or presenting rejected claims in better form for consideration on appeal. The present amendment amends Claims 1, 17, 18, 22-24, 42, and 45-48 to comply with the requirements of form expressed in the Office Action dated

November 17, 2009, and presents the rejected claims in better form for consideration on appeal. Therefore, this amendment only includes subject matter which was earlier presented. Thus, no new matter has been added, and this amendment does not raise new issues requiring further consideration and/or search. It is therefore respectfully requested that the present amendment be entered under 37 C.F.R. § 1.116.

CLAIM OBJECTION

Regarding the objection to Claim 24, Claim 24 has been amended in the manner suggested in the Office Action. Accordingly, the objection to Claim 24 is believed to have been overcome.

REJECTION UNDER 35 U.S.C. § 112

Applicant respectfully traverses the rejection of Claims 1-11, 18-21, and 42-45 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action asserts that those claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Office Action simply asserts that

the claimed target information type is much broader than the document type. **One of ordinary skill would not equate the claimed target information type to the document type (e.g., an apple is a fruit, but a fruit is not an apple).**

Thus, the Office Action asserts that

[t]here is no support in the original specification for claimed subject matters “target information type”, “target information type determination part”, and “target information type determination step”.

However, it is respectfully submitted that one skilled in the art would clearly recognize that the disclosed document (target document) is a non-limiting example of the claimed information (target information), based on at least page 109, line 19 to page 110, line 2 of the originally filed specification. Further, with respect to the document example, the specification clearly discloses an embodiment in which **a document type determination part** determines whether or not there is **a document type** acquirable from an image forming apparatus 1000 and writable in the image forming apparatus 1200 based on a transmitter document type list 302 and a receiver document type list 304.¹

Thus, one skilled in the art would recognize that, with respect to the claimed information (target information), the use of a determination part (or target information type determination part) that determines whether or not there is a target information type acquirable from an image forming apparatus 1000 and writable in the image forming apparatus 1200 based on a first processable target information type list and a second processable target information type list. Accordingly, the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicant was in possession of the “target information type”, “target information type determination part”, and “target information type determination part” as now claimed.

Should the Examiner disagree, it is respectfully requested that the Examiner provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed, in accordance with MPEP § 2163.04(II).

Therefore, Applicant respectfully requests that the rejection of Claims 1-11, 18-21, and 42-45 under 35 U.S.C. § 112, first paragraph, be withdrawn.

¹ See, e.g., Fig. 7 and the discussion related thereto in the originally filed specification.

Regarding the rejection of Claims 1, 17, 18, 22-24, 42, and 46-48 under 35 U.S.C. § 112, second paragraph, those claims have been amended to clarify that the determination is based on whether the target information type is “included in both” a first processable target information type list and a second processable target information type list. Further, it is respectfully submitted that one skilled in the art would recognize that the outcome of the determination is, with respect to Claim 1 as an example, a target information type that is processable by both an image forming apparatus and Web service providing apparatus. Accordingly, the rejection of Claims 1, 17, 18, 22-24, 42, and 46-48 under 35 U.S.C. § 112, second paragraph, is believed to have been overcome.

Regarding the rejection of Claim 45 under 35 U.S.C., § 112, second paragraph, Claim 45 has been amended to address the antecedent basis issue noted in the Office Action. Accordingly, the rejection of Claim 45 under 35 U.S.C. § 112, second paragraph, is believed to have been overcome.

REJECTION UNDER 35 U.S.C. § 103

Amended Claim 1 is directed to a Web service providing apparatus, comprising:

a controller including

a server processing part configured to control receipt of a process request for a process from a requesting apparatus connected to the Web service providing apparatus via a communication network, and to control transmission of a process response corresponding to the process request to the requesting apparatus in accordance with a predetermined protocol, the process request including a command to retrieve target information from an image forming apparatus connected to the Web service providing apparatus via the communication network;

a target information type determination part configured to determine a target information type that is processable by both the image forming apparatus and the Web service providing apparatus, the target information type determination part being configured to determine the target information type

based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus;

a condition acquisition control part configured to control, in response to an instruction from the server processing part, acquisition of the target information designated by the process request from the image forming apparatus that manages the target information based on the determined target information type; and

a service providing part configured to perform the requested process on the target information and to send a result of the process to the server processing part.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action acknowledges, and it is respectfully submitted, that the '786 patent fails to disclose the "target information type determination part" of Claim 1. Rather, the Office Action cites the '966 patent for such a teaching.²

The '966 patent is directed to a computer system and computer-implemented process for creation and maintenance of online services. In particular, the '966 patent discusses a client/server system, using a Web server, that allows for the creation and maintenance of an on-line service using a client system which remotely causes the server to perform operations required in an authoring process.³ The Office Action cites the '966 graphical user interface for teaching the claimed target information type determination part.⁴

However, it is respectfully submitted that the '966 patent fails to disclose a target information type determination part configured to determine a target information type that is processable by both the image forming apparatus and the Web service providing apparatus, the target information type determination part being configured to determine the target information type based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a

² See Office Action dated November 17, 2009, pages 7 and 8.

³ See '966 patent, column 9, lines 38-42.

⁴ See Office Action dated November 17, 2009, pages 7 and 8.

second processable target information type list of the Web service providing apparatus.

Rather, with respect to the cited '966 graphical user interface, the '966 patent simply discusses that a client application module 81 presents the graphical user interface to an end user via a computer screen or display. The '966 graphical user interface includes an interface for viewing a set of documents and the links between them, and an editing interface for editing a document. Further, the '966 patent discusses that from the graphical user interface, a user may request an outline view of the web link map view of the web, and a document summary view of the web.⁵ The '966 patent does not disclose any *determination of a target information type that is processable by both an image forming apparatus and an Web service providing apparatus*, as defined in Claim 1.

Thus, no matter how the teachings of the '786 and '966 patents are combined, the combination does not teach or suggest the "target information type determination part" of Claim 1. Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent claims) patentably defines over any proper combination of the '786 and '966 patents.

Amended Claim 17 recites, in part,

a determination step of determining a target information type that is processable by both the image forming apparatus and the Web service providing apparatus, the target information type being determined based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 18 recites, in part,

a service providing part configured to manage target information and to provide the target information to an image forming apparatus, which requests the target information based on a process request including a command to retrieve the target information from the Web service providing apparatus and performs a process on the target information, in accordance with a target information type received from the image forming

⁵ See '966 patent, column 15, lines 28-32 and 39-41.

apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 22 recites, in part,

a service providing step of managing, by the Web service providing apparatus, target information and providing the target information to an image forming apparatus, which requests the target information based on a process request including a command to retrieve the target information from the Web service providing apparatus and performs a process on the target information, based on a target information type received from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 23 recites, in part,

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is included in both a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Amended Claim 24 recites, in part,

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is included in both a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Amended Claim 42 recites, in part,

a service providing part configured to perform, in response to a process request, a process on target information received from an image forming apparatus that manages the target information in accordance with a target information type

and to provide a result of the process to the image forming apparatus, the process request including a command to retrieve the target information from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 46 recites, in part,

a service providing step of performing, by the Web service providing apparatus, in response to a process request, a process on target information received from an image forming apparatus managing the target information in accordance with a target information type and providing a result of the process to the image forming apparatus, the process request including a command to retrieve the target information from the image forming apparatus, the target information type being processable by both the image forming apparatus and the Web service providing apparatus and determined based on whether the target information type is included in both a first processable target information type list of the image forming apparatus and a second processable target information type list of the Web service providing apparatus.

Amended Claim 47 recites, in part,

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is included in both a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Amended Claim 48 recites, in part,

the target information type is processable by both the first image forming apparatus and the second image forming apparatus and determined based on whether the target information type is included in both a first processable target information type list of the first image forming apparatus and a second processable target information type list of the second image forming apparatus.

Regarding the rejections of Claims 17, 18, 22-24, 42, and 46-48 under 35 U.S.C. § 103(a), as noted above, the '786 and '966 patents, alone or in proper combination, fail to

disclose the "target information type determination part" of Claim 1. Thus, the '786 and '966 patents fail to disclose the target information type of Claims 17, 18, 22-24, 42, and 46-48, respectively. Accordingly, it is respectfully submitted that Claims 17, 18, 22-24, 42, and 46-48 (and all associated dependent claims) patentably defines over any proper combination of the '786 and '966 patents.

Regarding the rejections of dependent Claims 15 and 16 under 35 U.S.C. § 103(a), it is respectfully submitted that the '656 application fails to remedy the deficiencies of the '786 and '966 patents, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 15 and 16 patentably define over any proper combination of the '786 patent, the '966 patent, and the '656 application.

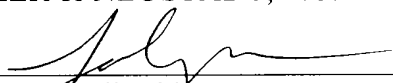
CONCLUSION

Thus, it is respectfully submitted that independent Claims 1, 17, 18, 22-24, 42, and 46-48 (and all associated dependent claims) patentably define over the '786 patent, the '966 patent, and the '656 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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